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EXAMINER

LEVINE, ADAM L

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/014,720

Applicant(s)

SHAER, ARI

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Oath/Declaration*

Examiner notes the presence of several extraneous papers included with the Oath. These papers, labeled Table 1I, 1J, and 1K are inconsistent with the application and may have been misfiled.

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: for example, reference character W3324 in Fig. 25. There are many similar instances in Figs. 25-30. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig. 1K is

missing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The disclosure is objected to because of the following informalities: On page 6 line 24, "step 10" should be "step 310." On page 6 lines 28-29 and page 7 line 5, the references to Figs. 1C and 1D are actually referring to Figs. 1D and 1E.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: The Summary of Invention is not a summary. It is equal in length to the Detailed Description. This is not helpful in gaining an overall understanding of the invention before examining the details in greater depth.

Appropriate correction is required.

Claims 10 and 17 are objected to because of the following informalities: Regarding Claim 10, it is unclear whether “in a specified geographical location within a specified time range” further defines the “specific event” or “options ... for payment of the desired goods.” Regarding Claim 17, removing the second and third commas would make the claim more understandable. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially similar" in claim 12 is a relative term that renders the claim indefinite. The term "substantially similar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The use of the term “substantially similar” to describe “a good or service desired for the event” relative to “a good or service desired for another event” renders the determination of the element “a good or service desired for the event” indefinite.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims include steps of creating and manipulating a database without any tangible technological medium incorporating said database. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in

memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-14, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson (U.S. Patent No. 6,609,106).**

Referring to Claim 1, Robertson discloses throughout a method for an event organizer to arrange the receipt of gifts for the event and services rendered in conjunction with the event, comprising the steps of:

creating an on-line database of gifts and services desired by the organizer throughout, but for example at column 3 lines 16-17, column 2 lines 14-17, column 12 lines 26-41, column 14 lines 40-52, and column 18 lines 13-17,

obtaining a first price for the gifts and services in the database at column 15 lines 15-31,

enabling access by gift givers to the database, for example at column 15 lines 50-62,

displaying to the gift givers the gifts and services in the database and a second price for the gift and services and enabling the gift givers to select one or more of the gifts and services for purchase on behalf of the organizer, the second price being a suggested retail price greater than or equal to the first price, for example at column 1 lines 35-43, column 2 line 63 – column 3 line 1, column 15 lines 21-30, column 18 lines 34-57, column 19 lines 19-23, and column 23 lines 19-56. It is clearly taught in Robertson's discussion of prior art at column 1 lines 35-43 that at least two different prices exist for any item sold in a retail environment. This is firmly established within Robertson's system and method at column 2 line 63-column 3 line 1, at column 15 lines 21-30, and at column 19 lines 19-23, where Robertson teaches the existence of different prices for the same item, and at column 25 lines 35-39 where Robertson discusses a credit for the registrant towards future purchases for all purchases made on their behalf. The only possible source for this credit is the difference in price reflecting a higher price paid by the purchaser than the price originally paid by the provider or reseller. This effectively establishes that the item is sold at a second price relative to the first price at which the item is initially acquired by the service or reseller. This aspect of the invention is also inherent in any retail environment.



Robertson discloses directing one of the gift and service providers to forward the gift to the organizer or perform the services for the organizer upon receipt of funds from the gift givers equal to the second price at column 24 lines 9-24 and in Robertson Claim 3.

**Referring to Claim 2,** Robertson discloses the method of Claim 1, wherein the step of creating the database comprises the steps of: displaying different categories of gifts and services to the organizer, enabling the selection of each of the categories of gifts and services, and for each category, displaying different gifts or services and enabling the selection of each of the gifts and services, whereby the organizer is able to select either categories of gift and services for entry into the database, specific gifts and services within each category for entry into the database or a combination thereof at column 22 lines 30-41, column 14 lines 40-52, and in Robertson Claims 9-12, and 16.

**Referring to Claim 3,** Robertson discloses the method of Claim 1, wherein the step of obtaining a first price for the gifts and services comprises the step of contacting gift and service providers to solicit bids from the gift and service providers at for example column 15 lines 19-31, discussing contacting providers and obtaining prices.

**Referring to Claim 4,** Robertson discloses the method of claim 1, wherein the step of obtaining a first price for the gifts and services comprises the step of conducting an auction among possible providers to obtain a lowest price for the gifts and services at column 15 lines 19-31, and column 19 lines 19-33.

**Referring to Claim 5,** Robertson discloses the method of claim 3, further comprising the step of: enlisting providers of gifts and services to submit bids for gifts and

services listed in said database, and electronically notifying the providers when one of the gifts and services provided by the gift and service provider is included in the database at column 3 lines 47-54, where providers register items for sale and are notified upon the occurrence of certain events, and at column 9 lines 25-37. Such events could be the inclusion of the providers' gift or service in the database. Regardless, such notification is inherent in Robertson.

**Referring to Claim 6**, Robertson discloses the method of claim 1, wherein the step of obtaining a first price for the gifts and services comprises the step of obtaining a price from several gift and service providers for each gift and service, further comprising the steps of: enabling access to said database by the organizer, displaying the gifts and services and the prices provided by the gift and service providers, and enabling the organizer to purchase the gift and services from any of the gift and service providers that submitted a price for the gift and services at, for example, column 15 lines 19-31, and column 19 lines 5-23.

**Referring to Claim 7**, Robertson discloses the method of claim 1, further comprising the steps of: determining a difference between the first and second price upon receipt of funds from the gift giver equal to the second price, and directing a first portion of the difference in price to an account of the organizer for use by the organizer in purchasing gifts and services in the database at column 25 lines 35-39. Robertson discusses a credit for the organizer (registrant) towards future purchases for all purchases made on their behalf. The only possible source for this credit is the difference in price reflecting the higher price paid by the gift giver (purchaser).

**Referring to Claim 8**, Robertson discloses the method of claim 1, wherein the step of creating the database comprises the steps of: providing a website to enable creation of the database, displaying options of different gifts and services to the organizer at the website, and displaying advertising of providers of gifts and services at the website at column 1 lines 50-60, column 2 lines 26-34, column 9 lines 5-45, column 10 lines 17-34, column 11 lines 25-42, in claims 1, 2, 9, and 16, and throughout.

**Referring to Claim 9**, Robertson discloses a method for coordinating payment for products and services in connection with an event, comprising the steps of:

creating a database of goods and services desired by an event organizer for the event with an associated cost at column 2 lines 14-17, column 3 lines 16-17, column 12 lines 26-41, column 14 lines 40-52, column 18 lines 13-17 and elsewhere throughout;

enabling others to access the database and commit to payment for the desired goods and services at column 22 line 59 – column 24 line 24;

associating the manner of payment with the desired goods and services; and upon acceptance by a provider of the goods and services to the manner of payment associated with the goods and services, contractually obligating the provider of the goods and services to deliver the goods and services for the event at column 25 lines 5-13, column 12 lines 11-13, column 23 line 66 – column 24 line 23, and in claim 12.

**Referring to Claim 10**, Robertson discloses the method of claim 9, further comprising the step of displaying options to the others for payment of the desired goods and

services for specific events or parties in a specified geographical location within a specified time range at column 25 lines 5-13.

**Referring to Claim 11**, Robertson discloses the method of claim 9, further comprising the step of soliciting providers of goods and services to commit to provide the goods and services at the associated cost at column 13 lines 5-18 and 23-27.

**Referring to Claim 12**, Robertson discloses the method of claim 9, wherein the step of creating a database for the event comprises the steps of determining whether a good or service desired for the event is the same or substantially similar to a good or service desired for another event as contained in a database for the other event, and if so, notifying potential providers of the good or services of the presence of multiple requests for the same or similar good or service at column 13 lines 5-15 and column 16 lines 50-59.

**Referring to Claim 13**, Robertson discloses a method for planning an event, comprising the steps of:

providing memory media having data encoded thereon in computer useable form, the data comprising a plurality of different templates and associated prices, each of the templates including information about goods and services for an event at column 25 lines 28-34 and in claims 1 and 14, Robertson's lists of gift items, which could include services, and distribution lists are the same as templates with prices and other information about goods and services for an event;

enabling event organizers to interface with the memory media and peruse the templates; enabling the event organizers to select one of the templates in Robertson claim 16;

and upon selection of one of the templates and after at least partial payment by the event organizer (user or registrant) for the selected template, informing providers of the goods and services associated with the selected template of a request to provide the goods and services listed in the template to the event organizer at column 10 lines 5-16.

**Referring to Claim 14**, Robertson discloses the method of claim 13, further comprising the step of: directing compensation to the creator of the selected template at column 25 lines 35-39.

**Referring to Claim 17**, Robertson discloses the method of claim 13, further comprising the step of: enabling the creation of a new template by presenting options for goods and services for an event, for each good and service presenting the identity of one or more providers of the good or service and contractually obligating the provider of the good or service to deliver the good or perform the service upon acceptance of the template by an event organizer in claims 1-9 and as discussed above with regard to creating lists (templates) and choosing providers.

**Referring to Claim 18**, Robertson discloses a method for enabling a user to obtain a service, comprising the steps of:

providing memory media having data encoded thereon in computer useable form, the data comprising a plurality of different templates and associated prices, each of the templates including information about a particular service;

enabling the user to interface with the memory media and peruse the templates;

enabling the user to select one of the templates; and

upon selection of one of the templates and after a commitment for payment by the user for the selected template, informing the provider of the service associated with the selected template of a request to provide the service according to the template to the user

in at least Robertson's claims 1 and 14, and as discussed above with regard to claim 13 of the present application.

**Referring to Claim 19**, Robertson discloses the method of claim 18, further comprising the step of: operating a web site at which the user interfaces with the memory media as discussed above with regard to claim 8 of the present application.

**Referring to Claim 20**, Robertson discloses the method of claim 18, further comprising the step of: requiring the user to provide partial payment upon selection of one of the templates; and guaranteeing at least partial payment to the provider of services associated with the template upon commitment by the provider to perform the services for the user as discussed above at least with regard to claims 9 and 10 of the present application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson as applied to claim 13 above, in view of Hammons (U.S. Patent No. 6,477,509).**

Referring to Claim 15, Robertson discloses the method of claim 13, further comprising the steps of: creating a digital or analog recording, video or photographs of an event using each of the templates in Robertson claim 13, where the videographer referred to in Robertson would clearly be hired for no other purpose. Robertson does not disclose enabling the event organizers to view the digital or analog recordings, videos or photographs after selection of the template. Hammons (U.S. Patent No. 6,477,509) teaches enabling the event organizers to view the digital or analog recordings, videos or photographs after selection of the template at column 1 lines 18-21 and 43-48, and at column 4 lines 55-60. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Robertson to include enabling the event organizers to view the digital or analog recordings, videos or photographs after selection of the template as taught by Hammons in order to achieve the benefit of having taken the pictures in the first place. This capability would obviously attract more event organizers, increasing marketing and advertising opportunities for both the system and its providers. Increasing marketing and advertising opportunities is noted as a motivation for the inventions in both Robertson and

Hammons, for example see Robertson column 13 lines 23-34 and Hammons column 9 lines 13-23.

**Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson as applied to claim 13 above, in view of Leason (U.S. Patent No. 5,898,594).**

**Referring to Claim 16**, Robertson discloses the method of claim 13, however Robertson does not disclose said method further comprising the steps of: associating the identity of the creator of each of the templates and terms for consulting with the creator of the selected template with each of the templates, providing the identity of the creator of the selected template to the event organizer, and enabling the event organizer to consult with the creator of the selected template upon acceptance of the terms for consulting with the creator of the selected template. Leason (U.S. Patent No. 5,898,594) teaches associating the identity of the creator of each of the templates and terms for consulting with the creator of the selected template with each of the templates, providing the identity of the creator of the selected template to the event organizer, and enabling the event organizer to consult with the creator of the selected template upon acceptance of the terms for consulting with the creator of the selected template at, for example, column 2 lines 4-14, 22-23; and 54-67 (describing a saved, shared registry of items manipulated by parties on consultation with each other), column 6 lines 46-60, column 12 lines 29-51 (discussing combining and manipulating saved registries upon identification of user and customer), in Leason claims 1-9 and others.




It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Robertson to include associating the identity of the creator of each of the templates and terms for consulting with the creator of the selected template with each of the templates, providing the identity of the creator of the selected template to the event organizer, and enabling the event organizer to consult with the creator of the selected template upon acceptance of the terms for consulting with the creator of the selected template as taught by Leason in order to streamline the process of planning an event or a gift list, making it easier for the planner to take advantage of the services provided by the service providers and thereby increasing commercial opportunities. These motivations are suggested in Robertson (at least in the abstract) and in Leason column 1 line 60 – column 2 line 29.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 703.305.0836. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 703.308.1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine  
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March 4, 2005



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